REMARKS

Claims 1-21 were submitted for examination. Claims 1-21 have been rejected. Reconsideration and reexamination of the above-referenced patent application is respectfully requested in view of the following remarks.

Rejection Under 35 USC §103 Over Ichimura et al. and Kikinis et al.

Claims 1-9, 12-14, 17-19 and 21 have been rejected under 35 U.S.C. §103 as being unpatentable over U.S. Patent No. 5,648,762 of Ichimura et al. ("Ichimura") in view of U.S. Patent No. 5,793,957 of Kikinis et al. ("Kikinis").

To establish *prima facie* obviousness of a claimed invention, all the claim limitations must be taught or suggested by the prior art. *In re Royka*, 490 F.2d 981, 180 USPQ 580 (CCPA 1974). (Manual of Patent Examining Procedure (MPEP) ¶ 2143.03).

Applicant's independent claims 1, 12, and 17, include limitations that are not disclosed nor suggested by the Ichimura or Kikinis references. As a result, Applicant's independent claims are patentable over the Ichimura and Kikinis references.

In particular, Applicant's independent claims 1, 12, and 17, include the limitation, or a limitation similar thereto, of:

> a housing to enable the device to be docked into a notebook computer having a memory to store an operating system;
> an interface disposed on a surface of the housing to enable communication between the device and the notebook computer when the device is docked; [and]
> <u>a memory to store an operating system; and</u>
> a processor to operate as a system processor of the notebook computer when the device is docked and to operate as a system processor of the device when the device is undocked. (applicant's claim 1 as amended).

As is apparent from the limitations shown in applicant's claim, applicant is claiming a core computer that is instertable into a notebook computer to have a processor of the core computer support the notebook computer.

Ichimura, however, only disclose inserting a notebook into a <u>docking station</u>, rather than a notebook computer (or base computer) as is claimed by applicant.

"A built-in electronic apparatus used where a notebook personal computer is inserted into a docking station main body." (Ichimura, abstract). **The item 200 of Ichimura, which the examiner refers to as the (computer 200) is not a computer but rather only a docking station.**

Therefore, considering Ichimura only discloses inserting a notebook into a <u>docking station,</u> clearly Ichimura does not disclose nor suggest applicant's claimed limitation of a core computer that is instertable into a notebook computer to have a processor of the core computer support the notebook computer.

Furthermore, as previously stated in a prior response, Kikinis also does not disclose a notebook computer with a docking bay for a device that includes a

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processor, which operates as a system processor of the notebook computer when the device is docked and operates as a system processor when the device is undocked. Rather, the Kikinis disclosure is limited to disclosing a notebook computer with a docking bay for a PCMCIA card, not a device with a system processor, as is claimed by Applicant.

As a result, applicant's independent claims are patentable over Ichimura and Kikinis.

The Examiner further states that one of ordinary skill in the art would have been motivated to replace the desktop disclosed in Ichimura with a notebook computer because a notebook computer is more portable. However, to do so would destroy the intended function of Ichimura.

> If proposed modifications would render the prior art invention being modified unsatisfactory for its intended purpose, then there is no suggestion or motivation to make the proposed modifications. *In re Gordon,* 733 Fed. 2d 221 USPQ 1125 (Fed. Circuit. 1984). (MPEP §2143.01).

. The intended function of Ichimura is to provide a desktop device that is able to dock a laptop computer. The motivation is to provide docking by a non-mobile device (e.g. desktop computer) for a mobile computer. (Ichimura, col. 1, lines 24-30). The motivation for Ichimura for docking laptop to a desktop device is that the desktop device is not mobile as is the notebook. (Ichimura, col. 1, lines 24-30). For example: "Another object of the present invention is to provide a built-in electronic apparatus which prevents the detachment of devices by an unauthorized person." (Ichimura, col. 1, lines 44-47). Therefore, to replace a desktop device with a mobile computer would further defeat the intended objective of preventing unauthorized persons from taking docked computer because the desktop device would be mobile.

Additional Rejections Under 35 USC §103

Claims 10, 11, 15 and 20 have been rejected under 35 U.S.C. §103(a) as being unpatentable over U.S. Patent No. 5,648,762 of Ichimura et al. ("Ichimura ") and U.S. Patent No. 5,793,957 of Kikinis et al. ("Kikinis") in view of U.S. Patent No. 5,884,049 of Atkinson.

Claims 16 has been rejected under 35 U.S.C. §103 as being unpatentable over U.S. Patent No. 5,648,762 of Ichimura et al. ("Ichimura ") and U.S. Patent No. 5,793,957 of Kikinis et al. ("Kikinis") in view of U.S. Patent No. 5,754,798 of Uehara et al.
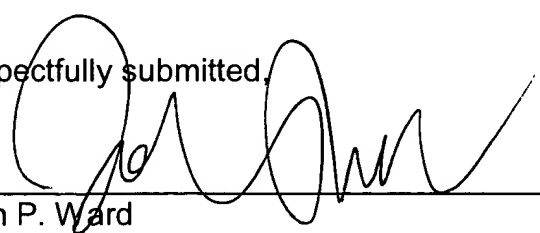
Applicant's remaining claims depend from at least one of the independent claims discussed above, and therefore include the distinguishing claim limitations as discussed above. As a result, Applicant's remaining claims are also patentable over Ichimura, Kikinis, Atkinson, and Uehara.

Conclusion

In view of the amendments, including broadening amendments, and remarks set forth above, Applicants respectfully submit that the now pending claims are in condition for allowance.

Respectfully submitted,

Date: 03/24/2003

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APPENDIX A

<u>VERSION OF SPECIFICATION AND CLAIMS</u>
<u>WITH MARKINGS TO SHOW CHANGES MADE</u>

<u>IN THE CLAIMS</u>

1.   (Amended) An electronic device comprising:

      a housing to enable the device to be docked into a notebook computer

          <u>having a memory to store an operating system</u>;

      an interface disposed on a surface of the housing to enable

          communication between the device and the notebook computer when

          the device is docked; [and]

      <u>a memory to store an operating system; and</u>

      a processor to operate as a system processor of the notebook computer

          when the device is docked and to operate as a system processor of

          the device when the device is undocked.

2.   The electronic device of claim 1, further comprising an input controller to receive input data into the device when the device is undocked.

3.   The electronic device of claim 2, further comprising core memory to store the input data when the device is undocked.

4.   The electronic device of claim 3, further comprising an output controller to provide output data from the device when the device is undocked.

5.   The electronic device of claim 4, further comprising a visual display disposed on a surface of the housing, the visual display being coupled to the input controller to provide the input data via pen-based entries on the display and being coupled to the output controller to provide the output data via the display.

6.   (Amended) The electronic device of claim 1, wherein the memory is a [further comprising] core memory [having stored thereon] to store a mini operating system.

7.   The electronic device of claim 1, further comprising a battery to provide power to the processor when the electronic device is undocked.

8.   The electronic device of claim 7, wherein the interface is coupled to the battery to charge the battery when the electronic device is docked.

9.   The electronic device of claim 8, wherein the notebook computer is to provide power to the processor when the electronic device is docked.

10.   The electronic device of claim 9, wherein the processor is to operate at a higher frequency and at a higher voltage when the device is docked than when the device is undocked.

11. The electronic device of claim 1, wherein the processor is to operate at a higher frequency and at a higher voltage when the device is docked than when the device is undocked.

12. (Amended) A base computer comprising:

a docking port to receive a hand-held core computer having a processor to operate as a system processor of the base computer when the device is docked and to operate as a system processor of the core computer when the device is undocked, the hand-held core including a memory to store an operating system; [and]

an interface in the docking port to enable communication between the core computer and the base computer when the core computer is docked; and

a memory to store an operating system.

13. (Amended) The base computer of claim 12, wherein the [further comprising base] memory [having stored thereon] of the base computer to store a full operating system, the [core computer comprising core] memory of the hand-held core to store[having stored thereon] a mini operating system.

14. The base computer of claim 12, wherein the interface is to couple a power supply of the base computer to a battery in the core computer to charge the battery and to provide power to the processor when the core computer is docked.

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15.   The base computer of claim 14, wherein the processor is to operate at a higher frequency and at a higher voltage when the processor operates as a system processor of the base computer than when the processor operates as a system processor of the core computer.

16.   The base computer of claim 12, wherein the processor is to operate in one of a high power mode and a low power mode according to user preference.

17.   (Amended) A method of operating a computer system comprising:
      operating a processor as a system processor of a notebook computer when a core computer is docked in a docking port of the notebook computer, the notebook computer including a memory to store an operating system; and
      operating the processor as a system processor of the core computer when the core computer is undocked, the core computer including a memory to store an operating system.

18.   The method of claim 17, further comprising synchronizing memory of the notebook computer with memory of the core computer when the core computer is docked.

19.   The method of claim 17, further comprising charging a battery in the core computer when the core computer is docked.

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20.	The method of claim 17, wherein operating the processor as a system

processor of the notebook computer includes operating the processor at a

higher frequency and voltage than when operating the processor as a system

processor of the core computer.

21. The method of claim 17, wherein operating the processor as a system processor of the notebook computer includes running a full operating system on the processor, and operating the processor as a system processor of the core computer includes running a mini operating system on the processor.